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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,775	02/15/2001	John Wankmueller	AP33001-070457.0972	2264
21003 7590 05/26/2011 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498				
EXAMINER JOHNSON, GREGORY L				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 05/26/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

09/783,775

Applicant(s)

WANKMUELLER, JOHN

Examiner

GREGORY JOHNSON

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 6, 8 and 10 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on November 30, 2010, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691

Status of Claims

2. Claims 1, 7 and 9 have been cancelled during prosecution. Claims 2, 3, 6 and 8 are amendment. Claims 4 and 10 are as previously presented. Claim 5 is original. Claims 2-6, 8 and 10 are pending.

Response to Arguments

3. Applicant's arguments, see pages 12-16, filed November 30, 2010, with respect to **claims 2, 6, 8 and 10** have been fully considered and are persuasive. The rejection of November 30, 2009 has been withdrawn.

4. Applicant's arguments, see page 15, filed November 30, 2010, with respect to the rejections of **claims 3-5** under 35 U.S.C. § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the combination of Paltenghe et al., Pub. No. 2002/0004783 (hereinafter "Paltenghe") and "First SET transaction on the internet", Financial Technology International Bulletin (hereinafter "FTiB").

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, in view of FTiB.

As to claim 3, Paltenghe teaches,

- a remote wallet server for facilitating a payment transaction over a computer network between a consumer and a merchant (abstract, ¶¶0023, ¶¶0045, ¶¶0067 and ¶¶0071; which discusses a wallet that resides remotely with a server, a wallet owner, a merchant and a card issuer),
- wherein the transaction involves a payment card issued by an issuer institution to the consumer (abstract, ¶¶0023, ¶¶0045, ¶¶0067 and ¶¶0071)

- wherein the payment card is in a form of either a chip card or a non-chip card (§0015, §0059 and §0097-0099; which discusses a virtual wallet using credit cards, debit cards, smart cards, etc.), and
- wherein the computer network includes at least three computers connected thereto, a consumer computer operated by or on behalf of the consumer, a merchant computer operated by or on behalf of the merchant, and the wallet server at a location remote from said consumer (abstract, §0045-0047 and §0071; which discusses a hybrid wallet comprising the wallet owner's personal computer and a remote portion of the wallet residing on a remote server; and a merchant server);
- the remote wallet server comprising: a microprocessor unit; a memory unit coupled to the microprocessor unit; means for conducting a payment function between the remote wallet server and the merchant computer in response to a request for such a function by the consumer computer (§0045-0059).

Paltenghe teaches the use of protocols, such as SET, Visa Cash, Mondex and OPS, which virtual wallet system uses to interact with other systems and servers. For example, the wallet server may utilize the Secure Electronic Transaction (SET) protocol, or any other similar transaction protocol, to exchange the payment information such as the wallet owner's account number, the amount of the payment, and the authorizations. Paltenghe also teaches the use of a protocol registry that allows the framework to include protocols, like SET, that effects operations like payment authorization for a credit card.

Paltenghe, does not teach the following element; however, FTiB discloses the element:

- wherein the payment transaction is conducted in a format compliant with a chip card electronic commerce protocol or specification (2nd page; which discusses using the existing EMV chip card specs with the SET protocol for online credit card payments).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the virtual wallet system as taught by Paltenghe, with the aforementioned limitation as disclosed by FTiB for the motivation to provide additional safeguards for online shopping, such as optional cardholder verification as well as to store cryptographic keys and digital certificates.

Allowable Subject Matter

8. **Claims 2, 6, 8 and 10** are allowed.
9. **Claim 4** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. **Claim 5** is objected, however, claim 5 would be allowable if Applicant overcame the objection of claim 4, based on the dependency of claim 5 on claim 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GREGORY JOHNSON/
Primary Examiner, Art Unit 3691